

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/524,094

Applicant(s)

KOVATCHEV ET AL.

Examiner

LORI A. CLOW

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): The rejection under 35 USC § 112, 1st paragraph for new matter. The rejection is hereby withdrawn in view of Applicant's arguments pointing to specific support for the claim amendments.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-39 and 112-226

Claim(s) withdrawn from consideration: 40-111

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
The outstanding rejections are maintained for the reasons of record and re-iterated below with response to arguments

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☒ Other: Interview Summary form attachment

/Lori A. Clow, PhD/
Primary Examiner
Art Unit: 1631

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18, 135-154, and 195-214 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, for the reasons set forth in the previous Office Action and re-iterated below.

Claims 1-18, 135-154, and 195-214 are non-statutory because they also read on abstract ideas. The prohibition on patenting abstract ideas has two distinct aspects: (1) when an abstract concept has no claimed practical application, it is not patentable; (2) while an abstract concept may have a practical application, a claim reciting an algorithm or abstract idea can state statutory subject matter only if it is embodied in, operates on, transforms, or otherwise is tied to another class of statutory subject matter under 35 U.S.C. §101 (i.e. a machine, manufacture, or composition of matter). (Gottschalk v. Benson, 409 U.S. 63, 175 USPQ 673, 1972) as clarified in In re Bilski, 545 F.3d 943, 88 USPQ2d 1385 (Federal Circuit, 2008), the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus or (2) transforms a particular article to a different state or thing.

Claims 1-18, 135-154, and 195-214 are not so tied to another statutory class of invention because the method steps that are critical to the invention are "not limited to any particular apparatus or machinery." Claim limitations directed to obtaining or outputting data using an apparatus or machine are considered insignificant pre-solution and post-solution activity.

Response to Applicant's Arguments

Applicant argues that the Office Action errs by requiring the present invention to be tied to a particular machine AND to transform a particular article into a different state or thing.

This is not persuasive. In contrast, the Office Action, as recited above, states that the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus OR (2) transforms a particular article to a different state or thing. As was stated before, with regard to a "particular machine", the instant claims do not meet this prong of the machine-or-transformation test, as there is no particular or specific machine recited. As such, one must then evaluate the claim to see if it can meet the other prong of the m-o-r-t test, which is transformation of a particular article to a different state or thing. In the recited claims, no such transformation takes place. Electronically transforming an estimate into a visual depiction is not central to the purpose of the claimed subject matter.

It is noted that the instant rejection could be overcome, for example, by performing a critical method step on a suitably programmed computer or processor

Claim Rejections - 35 USC § 112-2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-39 and 112-226 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Instant rejections set forth are necessitated by claim amendment.

Claims 1, 19, 37, 38, 135, 155, 195, 215, and 211 (and claims dependent therefrom), recite, "pre-processing the collected BG data to convert the collected BG data into derived BG data derived from collected BG data". It is unclear as to what is being derived about the BG data. The language appears to be redundant language. Clarification through claim language is requested.

Response to Applicant's Arguments

Applicant argues that a person having ordinary skill in the art would interpret the claim to require a pre-processing of collected BG data, i.e., data that can be obtained, for example, but not limited to, from a patient. After pre-processing, the BG data is simply referred to as derived BG data.

This is not persuasive. The claim language is confusing and redundant in that it repeats "derived data from said collected data". Therefore, the claim language is not clear. Clarification through clearer claim language is requested. It is suggested that the claim merely read, "pre-processing the collected BG data to convert the collected BG data into derived BG data".

No claims are allowed.

Applicant is invited to call the Examiner to discuss the rejections of record.

Inquiries

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The Central Fax Center Number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori A. Clow, Ph.D., whose telephone number is (571) 272-0715. The examiner can normally be reached on Monday-Friday from 10 am to 6:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on (571) 272-0720.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight 2(EST). The toll free number is (866) 217-9197. When calling please

have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

/Lori A. Clow, PhD/
Primary Patent Examiner
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